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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,802	10/10/2006	Jean-Marie Gouot	P/3610-71	5203

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EXAMINER	
PIHONAK, SARAH	

ART UNIT	PAPER NUMBER
4121	

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03/17/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/587,802	GOUOT ET AL.	
	Examiner	Art Unit	
	SARAH PIHONAK	4121	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/31/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This application is a 371 (national stage application) of PCT/EP05/02563, and claims foreign priority to Application No. 04356019.2, filed on 2/12/04, and Application No. 04356096.0, filed on 6/11/04. This application also claims priority to Provisional Application No. 60/637120, filed 12/17/04.

1. Claims 1-20 are pending.

Election/Restrictions

2. Claims 3 and 20 are withdrawn from consideration.

3. Applicant's election of the election of Group I, claims 1-19, in the reply filed on 2/6/09 is acknowledged. Additionally, upon the requirement for species election, Applicants elected the compound N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

4. Claims 3 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 2/6/09. Regarding instant claim 3, the claim states that the subscript q of formula (I) is equal to 2. However, the elected compound, N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide, has only one substituent on the phenyl ring, which is

equal to q = 1. Therefore, instant claim 3 is considered to be drawn to a non-elected invention, and is withdrawn form consideration.

Priority

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. This application claims priority to Application No. 04356019.2, filed on 2/12/04, and Application No. 04356096.0, filed on 6/11/04. The instant claims are therefore given the priority date of 2/12/04.

35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

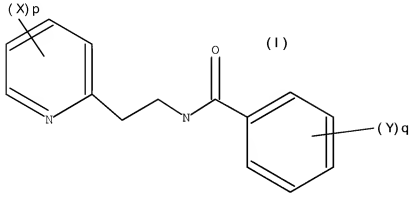
7. Claims 1-2, and 4-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 2001/11965, in view of WO 2002/069712, and further in view of Colby, *Weeds*, **15**, pp. 20-22, 1967. The '965 publication and the Colby reference were provided by the Applicants in the Information Disclosure Statement.

8. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Instant claim 1 cites a composition comprised of a compound (a), of formula (I), shown below:



The elected compound N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide is a species of formula (I). Instant claim 1 also cites that the composition comprises compound (b), which is defined as a compound capable of inhibiting electron transport in the respiration of phytopathogenic fungal organisms, and that the weight ratio of compound (a) to (b) is from 0.01 to 20. Claim 1 of the '965 publication also cites a compound, which includes the compound of general formula (I), and the elected species, N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide. The '965 publication also teaches that the N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide compound can be combined with a variety of antifungal agents (p. 10, paragraph [0041]).

10. Instant claim 2 cites the composition as stated in instant claim 1, and additionally, that the subscript p of formula (I) is equal to 2. This is also taught in claim 1 of the '965 publication, and the elected compound, N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide, is a species of this formula.

11. Instant claim 4 cites the composition as stated in instant claim 1, and also, that the X substituent is selected as either a halogen or haloalkyl. The elected compound, N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide, is a species of this formula. This is also taught in claim 1 of the '965 publication.

12. Instant claim 5 cites the composition as stated in instant claim 1, and furthermore, that the X substituent is selected from either a chlorine atom or a trifluoromethyl group. The elected compound, N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide, is a species of this formula. This is also taught by claim 1 of the '965 publication.

13. Instant claim 6 cites the composition as stated in instant claim 1, and additionally, that the Y substituent is chosen as either halogen or haloalkyl. The elected compound, N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide, is a species of this formula. This is also taught by claim 1 of the '965 publication.

14. Instant claim 7 cites the composition as cited in instant claim 1, as well as, that the Y substituent is either a chlorine atom or a trifluoromethyl group. The elected compound, N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide, is a species of this formula. This is also taught by claim 1 of the '965 publication.

15. Instant claim 8 cites the composition as stated in instant claim 1, and also, that the compound (a) is selected from three listed compounds, one of which is

the elected compound N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide. This is also taught by claim 1 of the '965 publication.

16. Instant claim 9 cites the composition as stated in instant claim 1, and also, that the compound (a) is the elected compound N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide. This compound is also taught by claim 1 of the '965 publication.

17. Instant claim 19 cites the composition as stated in instant claim 1, and also, that the composition is further comprised of an agriculturally acceptable support, carrier, filler, and/or surfactant. The '965 publication teaches that the composition may further be comprised of an agriculturally acceptable diluent or carrier (p. 9, paragraph [0039]), and surface-active agents (p. 10, paragraph [0042]).

18. Regarding instant claim 1, the '965 publication does not teach that the weight ratio of compound (a) to compound (b) in the composition is from 0.01 to 20. While the '965 publication teaches that the compound (a) may be combined with other anti-fungal agents (p. 10, paragraph [0041]), it does not specifically teach that the additional anti-fungal agents to be used inhibit electron transport.

19. Regarding instant claim 10, the '965 publication does not specifically teach that compound (b) of the composition is capable of inhibiting reduced nicotinamide-adenine dinucleotide dehydrogenase in phytopathogenic fungi.

20. Regarding instant claim 11, the '965 publication does not specifically teach that compound (b) of the composition, which is capable of inhibiting reduced

nicotinamide-adenine dinucleotide dehydrogenase in fungal organisms, is diflumetorim.

21. Regarding instant claim 12, the '965 publication does not specifically teach that compound (b) is a compound capable of inhibiting succinate dehydrogenase in phytopathogenic fungi.

22. Regarding instant claim 13, the '965 publication does not specifically teach that compound (b) is any one of the listed compounds in the instant claim.

23. Regarding instant claim 14, the '965 publication does not specifically teach that compound the additional anti-fungal agent is capable of inhibiting mitochondrial ubiquinol:ferricytochrome-c oxidoreductase in phytopathogenic fungi.

24. Regarding instant claim 15, the '965 publication does not specifically teach that compound (b) is any one of the listed compounds in the instant claim.

25. Regarding instant claim 16, the '965 publication does not specifically teach that compound (b) is one of the listed strobilurin derivative compounds listed.

26. Regarding instant claim 18, the '965 publication does not specifically teach that an additional compound (c) is one of the compounds listed in the instant claim.

27. Regarding instant claim 1, the '712 publication teaches that pyridinylbenzamide compounds, similar to the compounds taught in the instant application and the '965 publication, can be used as fungicide agents with additional compounds that are known to inhibit electron transport in phytopathogenic fungal organisms (p. 36-37, claim 1).

28. Regarding instant claim 10, the '712 publication teaches that the primary pyridinybenzamide compound can be combined with diflumetorim (p. 10, lines 9-28), which is known in the art to inhibit reduced nicotinamide-adenine dinucleotide dehydrogenase in fungal organisms.

29. Regarding instant claim 11, the '712 publication teaches that the primary pyridinylbenzamide compound can be combined with diflumetorim (p. 10, lines 11-21).

30. Regarding instant claim 12, the '712 publication teaches that the primary pyridinylbenzamide compound can be combined with an additional anti-fungal agent such as flutolanil (p. 10, lines 11-27), which is known in the art to inhibit succinate dehydrogenase in fungal organisms.

31. Regarding instant claim 13, the '712 publication teaches that the primary pyridinylbenzamide compound can be combined with flutolanil (p. 10, lines 11-27).

32. Regarding instant claim 14, the '712 publication teaches that the primary pyridinylbenzamide compound can be combined with a strobilurin derivative (p. 39, claim 9), which are known in the art to inhibit mitochondrial ubiquinol:ferricytochrome-c oxidoreductase in fungal organisms.

33. Regarding instant claim 15, the '712 publication teaches that the primary pyridinylbenzamide compound can be combined with a strobilurin derivative (p. 39, claim 9), which are known in the art to inhibit mitochondrial ubiquinol:ferritocytochrome-c oxidoreductase in fungal organisms.

34. Regarding instant claim 16, the '712 publication teaches that the primary pyridinylbenzamide compound can be combined with azoxystrobin (p. 39, claim 9).

35. Regarding instant claim 18, the '712 publication teaches that the primary pyridinylbenzamide compound may be combined with an additional anti-fungal agent such as captan (p. 10, lines 11-16).

36. The '712 publication does not teach, in reference to instant claim 1, that the weight ratio of the primary pyridinylbenzamide compound to the second anti-fungal agent is from 0.01 to 20.

37. Colby teaches a method for calculating the synergistic effect achieved when different herbicidal agents are combined in a composition (p. 20, formula IV). From this calculation, the optimal ratio of different herbicides could be determined. This calculation would also be useful towards antifungal agents. It is known in the art that compositions of antifungal agents possessing compounds with different modes of action are beneficial, to prevent resistance to fungicidal agents. The '965 publication teaches that the elected compound, N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide, may be combined with other fungicidal compounds, but does not specifically teach which agents. The '712 publication teaches that pyridinylbenzamide compounds can be combined with antifungal agents with that inhibit electron transport (p. 10, lines 3-29, and p. 11, lines 1-14), along with compounds with other modes of action. From the Colby reference, the optimal ratio of the elected compound, N-{2-[3-

chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide and the additional components can be determined, so that the composition may have the most beneficial fungicidal action. It is obvious that one could apply the teachings of the '965 publication, the '712 publication, and Colby to obtain an optimal ratio for different antifungal agents in the composition, and to arrive at the weight ratio range as stated in instant claim 1, to provide a composition with improved fungicidal action.

Claim Rejections-Obvious Double Patenting

38. Claims 1-2, 4-9, and 17-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 4-9, 12, and 15-17 of copending Application No. 10/588532, in view of Leroux, *Pest. Sci.*, **47**, 191-197, 1996. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose the same inventive concept.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

39. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

40. Instant claim 1 cites a composition comprised of the elected compound, N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide, and an additional compound (b), which is capable of inhibiting electron transport in cellular respiration of fungal organisms. Instant claim 1 also cites that the elected compound and (b) are combined in a weight ratio from 0.01 to 20. Claim 1 of Application No. 10/588532 also cites a fungicidal composition that is

comprised of the elected compound, N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide, and an additional compound (b), which is capable of inhibiting spore germination or mycelium growth in fungal organisms. Claim 1 of Application No. 10/588532 also cites that the elected compound is combined with compound (b) in a weight ratio from 0.01 to 20. While compound (b) of the instant application and Application No. 10/588532 appear to have a different mode of action, both applications include the term 'comprising'. For example, claim 12 of Application No. 10/588532 cites that the compound captan may be present in the fungicidal composition. It is known in the art that captan has a broader spectrum of anti-fungal activity that includes inhibiting spore germination, as well as inhibiting cellular respiration, as taught by Leroux (p. 191, right column, paragraph 2). Therefore, claims 1 and 12 of Application No. 10/588532 describe a fungicidal composition which has all of the elements of instant claim 1.

41. Instant claim 2 cites the composition as stated in instant claim 1, and also, that the subscript p of formula (I) is equal to 2. The elected compound, N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide, is a species of this formula. This is identical to what is disclosed in claim 2 of Application No. 10/588532

42. Instant claim 4 cites the composition as stated in instant claim 1, and also, that the X substituent of formula (I) is either halogen or haloalkyl. This is also cited in claim 4 of Application No. 10/588532.

43. Instant claim 5 cites the composition as stated in instant claim 1, as well as, that the X substituent is either a chlorine atom or a trifluoromethyl group. This is also what is disclosed in claim 5 of Application No. 10/588532.

44. Instant claim 6 cites the composition as stated in instant claim 1, and additionally, that the Y substituent is either halogen or haloalkyl. This is also what is disclosed in claim 6 of Application No. 10/588532.

45. Instant claim 7 cites the composition as stated in instant claim 1, and also, that the Y substituent is either a chlorine atom or a trifluoromethyl group. This is also what is cited in claim 7 of Application No. 10/588532.

46. Instant claim 8 cites the composition as stated in instant claim 1, and additionally, that the compound (a) of formula (I) is selected from a list of three compounds, one of which is the elected compound N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide. This is identical to what is stated in claim 8 of Application No. 10/588532.

47. Instant claim 9 cites the composition as stated in instant claim 8, and also, that compound (a) of formula (I) is the elected compound N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide. This is also what is cited in claim 9 of Application No. 10/588532.

48. Instant claim 17 cites the composition as stated in instant claim 1, and further includes a fungicidal compound (c). This is also disclosed in claim 15 of Application No. 10/588532.

49. Instant claim 18 cites the composition as stated in instant claim 17, and also, that the fungicidal compound (c) may be, in addition to captan,

tebuconazole. Tebuconazole is also listed as a composition component in claim 16 of Application No. 10588532.

50. Instant claim 19 cites the composition as stated in instant claim 1, and that the composition further comprises an agriculturally acceptable carrier, filler, support, and/or surfactant. This is identical to what is disclosed in claim 17 of Application No. 10/588532.

Information Disclosure Statement

51. The information disclosure statement (IDS) submitted on 7/31/06 was filed. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. All documents included in the IDS were considered, with the exception of FR 2821718. No English equivalent document was provided, and the reference was not considered by the Examiner.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARAH PIHONAK whose telephone number is (571)270-7710. The examiner can normally be reached on Monday-Thursday 7:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on (571)272-0847. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.P.

/Patrick J. Nolan/
Supervisory Patent Examiner, Art Unit 4121